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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/698,961	10/31/2003	Sivakumar Ramasamy	0275M-000666/COB	8815

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EXAMINER

SAETHER, FLEMMING

ART UNIT	PAPER NUMBER
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3677

MAIL DATE	DELIVERY MODE
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07/16/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/698,961

Applicant(s)

RAMASAMY ET AL.

Examiner

Flemming Saether

Art Unit

3677

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 April 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4-8,10-23,25-27,29-31,33,36-41 and 48-52 is/are pending in the application.
- 4a) Of the above claim(s) 19-22 and 48-52 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,4-8,10-18,23,25-27,29-31,33 and 36-41 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Election/Restrictions

Claims 19-22 and 48-52 remain in the application as withdrawn.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1, 2, 4-8, 10-18, 23, 25-27, 29-31, 33, and 36-41 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In claims 1 and 23, there is no antecedent basis for the fastener welded to the surface as required by limitation "upon the welding". In claims 8 and 18, "an annular weldment" appears to be a double inclusion since that feature has already been claimed as "an annular weldment area" and/or "annular weldment surfaces"; it is unclear how the "an annular weldment" can be different than the other annular weldments previously claimed. In claims 10, 18 and 31, it is unclear that the "web" refers to since it appears as if referring to the same features previously claimed as the head and, in at least claim 10, there is no antecedent basis for "the member" which includes the web. The claims were examined as best understood.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory

obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1, 2, 4-8, 10-18, 23, 25-27, 29-31, 33, and 36-41 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-6 of U.S. Patent No. 6,818,851. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the instant application are broader than those of the related patent thus the claims of patent 6,818,851 include all the limitations of the instant application.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 2, 6-8, 10-12, 14-18, 31, 33 and 36-41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bregenzer (GB 2,065,011) in view of Mielke (WO 03/022504). Bregenzer discloses a weldable fastener comprising a shank (10) and a head (20). The shank is described as a bolt thus it would inherently include threads. The fastener is also disclosed as being welded to a composite metal panel comprising metal sheets with a plastic core. The head of the fastener is disclosed as having an annular weldment area (24) having a flat lower surface (at 26) and extending from an outer periphery at a lower surface of a web portion of the head (22) so as to form a cavity when it is welded to the panel. The thickness of the weldment between the bottom surface of the head and the flat surface of the weldment being shown as about the same as the thickness of the head at the web and as such does not disclose the thickness of the weldment being less than half that of the head. Mielke also discloses a weldable fastener including an annular weldment (6G) which, in the embodiment of Fig. 9, can be seen as having a thickness less than half that of the remainder of the fastener. At the time the invention was made, it would have been obvious for one of ordinary skill in the art to make the fastener of Bregenzer with a weldment having a thickness less than half the thickness of the head as disclosed in Mielke because Mielke teaches it is known to vary the thickness of the weldment between a thickness which is equal to the head (see Mielke's Fig. 8) and a thickness which is less than half. The lesser thickness would provide a greater strength to the weldment and the fastener connection overall. The order to failure loads is an intended

use since as it would depend on the type of load and other external factors and the specific dimension would have obvious depending upon the particular application.

Claims 4 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over modified Breganzer as applied to claims 1, 8 and 10-12 above, and further in view of WO 03/042554. Assignee's prior publication, WO 03/042554, discloses the fastener to have a weakened portion. At the time the invention the invention was made, it would have been obvious to provide the device of the modified Breganzer with a weakened portion as disclosed in WO 03/042554 and for the same reasons to ensure the threaded shaft will be the first to fail.

Allowable Subject Matter

Claim 5 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Claims 23, 25-27, 29 and 30 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action.

As noted in the related application 10/714,500, now patent 6,818,851; the prior art does not disclose the more specific size relation of the weldment to the head.

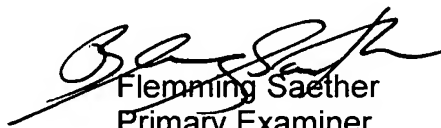
Conclusion

Applicant's remarks have been considered but are moot in view of the new grounds of rejection.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Flemming Saether whose telephone number is 571-272-7071. The examiner can normally be reached on Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Judy Swann can be reached on 571-272-7075. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Flemming Saether
Primary Examiner
Art Unit 3677